

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 13-18 remain in this application. Claims 1-12 and 19-23 have been withdrawn as the result of an earlier restriction requirement, and applicant retains the right to present those claims in a divisional application.

The examiner objects to figures 29-35 as being prior art but not being so labeled. The proposed drawing amendments have been submitted as requested by the Examiner.

The examiner objects to figure 32 for not having reference numbers referred to in the specification. The specification has been amended to make it consistent with figure 32, making the objection moot.

Claims 14-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA). Claim 16 was rejected under 35 U.S.C. §103(a) as being unpatentable over (AAPA in view of Provino *et al.* (U.S. 6,601,081). For the following reasons, the rejections are respectfully traversed.

Claim 14, as amended, recites a "storing means for storing power-saving mode information of each of a plurality of hardware devices in respective operating systems". The Background of the application (which the Examiner calls AAPA) does not suggest any means of storing "power saving mode information of each of a plurality of hardware devices" as recited in the claim.

The Examiner states that it is "obvious that there exists storage means in the respective operating systems to store the power saving mode information so that as the operating systems receive and relinquish control of the devices, the operating systems could still return the devices back to a previous power saving mode initiated by those previous operating systems".

However, such logic assumes that there is a teaching that "the operating systems

could still return the devices back to a previous power saving mode initiated by those previous operating systems". The Examiner has not shown where in the Background of the specification the applicant has said that such a "return" requirement is known. In fact, there is no such teaching.

Furthermore, the Examiner's logic is faulty. The Background discusses that, for example, "if the power-supply OFF is requested from the OSB in operation of the OSA, such a process is carried out that the power supply is turned OFF once, and then the power supply is turned ON again to continue the process of the OSA" (page 4, second full paragraph). Accordingly, there is no need to store power saving mode information to execute such a process. All the operating systems would need to know is what the desired state of a device is (i.e., the request), and what the current state of the device is (i.e., ON or OFF). There is no need to store any mode information at all. Thus, the Examiner's logic does not follow from the teaching, and there is no inherent need for any storage means.

Consequently, because the applicant has not admitted, nor implied, the need for any storage means in the prior art, the AAPA cannot suggest the cited storage means, and thus claim 14 is patentable over the reference.

Furthermore, claim 14, as amended, recites "a power-saving mode switching/controlling means for controlling process execution of the request based on the stored power-saving mode information, and *waiting to set a power saving mode, according to the request, until the computer system is switched to said one of the operating systems* (emphasis added). It is clear that the applicant's background does not teach any such "waiting" as recited in the claim. Thus, for this reason as well, claim 14 is patentable over the AAPA.

Claims 15 & 16, which depend on claim 14, are thus patentable for at least the same reasons as claim 14.

Furthermore, the Examiner has not provided the proper motivation for modifying the AAPA. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the prior art (MPEP §2143.01). The prior art must suggest the *desirability* of the modification (*Id.*).

However, the motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

“To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention ‘*as a whole*’ would have been obvious at that time to that person.” (MPEP §2142, emphasis added). In this case, the Examiner must be relying on the application itself for the motivation to modify the AAPA, because the Examiner has cited no other references, and this is clearly improper. The Examiner must find some motivation for modification outside of the application, and cannot rely on the application itself.

Accordingly, the rejection for obviousness is not supported by the Office action and thus the rejection is improper, and should be withdrawn.

Claims 13, 17, and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over AAPA in view of Holtzhammer. (U.S. 6,092,209). For the following reasons, the rejection is respectfully traversed.

First, claims 13, 17, and 18, as amended, each recite a “storing means” similar to claim 14, as discussed above. Holtzhammer does not overcome the shortcomings of the AAPA, and thus the claims are patentable for the same reasons as discussed for claim 14.

In addition, claim 13 recites a “power-supply switching/controlling means for controlling process execution of the request based on the stored execution information, and not-performing the process execution of the request when another operating system is using the one or more of the hardware devices”.

The Examiner cites Holtzhammer as teaching not performing a power transition in a device while the device is busy. However, Holtzhammer does not suggest utilizing “stored execution information” to make such a determination. In fact, Holtzhammer teaches away from the invention, because, one skilled in the art would know that, by changing operating systems, the device may very well be idle when another operating system is in control, and thus would still shut the device down (because it would not be busy) even if another operating system were using the device. There is no teaching in Holtzhammer of

accommodating multiple operating systems, and thus the reference is silent as to such a scenario. Thus, combining Holtzhammer with the AAPA fails to teach the cited limitation, and thus for this reason as well, claim 13 is patentable over the references.

Claims 17 and 18 also recite the storage means for "saving power-saving mode information of the virtual computer". Neither the AAPA, nor Holtzhammer, suggest saving any such information, and such storage is not inherent in either device (see analysis for claim 14, and the fact that Holtzhammer does not discuss any virtual computer). Accordingly, for this reason as well, claims 17 & 18 are patentable over the AAPA and the references.

Furthermore, claim 17 recites a "power-saving mode switching/controlling means for controlling process execution of the request based on the power-saving mode information, and setting/changing a power-saving mode by *comparing* the power-saving mode information of the operating system with the power-saving mode information of the virtual computer system". Because neither the AAPA nor the references suggest any "comparing" as discussed in the claim, claim 17 is patentable over the AAPA and the references for this reason as well.

Further, Claim 18 recites "a power-saving mode switching/controlling means for controlling process execution of the request based on the power-saving mode information, and setting/changing a power-saving mode by *comparing* the power-saving mode information of a switched operating system with the power-saving mode information of the virtual computer system when the operating system is switched". Because neither reference suggests any "comparing" as discussed in the claim, claim 18 is patentable over the AAPA and the references for this reason as well.

Additionally, as discussed for claim 14, the Examiner has not provided the proper motivation for modifying the AAPA to obtain the invention of claims 13, 17, and 18, because it again appears that the Examiner is relying on the application itself to provide the motivation, and thus the rejections for obviousness are improper.

Finally, new claim 24 contains a number of limitations similar to those discussed above, and thus is patentable over the AAPA and the references for at least the same reasons.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it

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is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 33452.

Respectfully submitted,

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Amendments to the Drawings:

The attached sheets of drawings includes changes to Figs. 29-35, which have been marked as being "Prior Art". These sheets replace the original sheets including Fig. 29-35.

Attachment: Replacement Sheets.